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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,225	04/09/2001	Michael G. Alliston	0386/00295	5617

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EXAMINER
LEUNG, JENNIFER A

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/828,225	Applicant(s) ALLISTON ET AL.	
	Examiner Jennifer A. Leung	Art Unit 1764	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

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PRIMARY EXAMINER

Continuation of Item 11.

The request for reconsideration has been considered, but it does not place the application in condition for allowance for the same reasons set forth in the Final Office Action.

Comments regarding the rejection of claims 4, 5, 7, 17, 20, 21, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Hyppanen (WO/97/46829).

On page 3, second to last paragraph, Applicants argue,

> "In Hyppanen, the dilution chamber **216**, which may be considered an inlet chamber, is not located inside the furnace (reaction chamber **212**) and further does not have an open top as recited in claim 24... the reaction chamber outlet **226** is the inlet to the dilution chamber **216**. The use of the term "reactor chamber outlet **226**" makes it clear that the material is directed outside the reactor chamber **212**, and the reactor chamber outlet **226** is not located inside the reactor chamber **212**. Additionally, unlike the recited inlet chamber, the dilution chamber **216** does not have an open top, but is rather topped by the inclined reactor chamber outlet **226**. Thus, the chamber **216** does not possess the properties of the claimed inlet chamber."

On page 3, last paragraph, Applicants further argue,

> "... the Examiner asserted that portions of the description in Hyppanen (preceding the detailed description of the embodiments) suggest the possibility of locating process chambers inside the furnace... page 1, lines 17-22 of Hyppanen states that "[t]he heat transfer chamber may in some special case even be formed within the processing chamber itself." However, this statement is located in the FIELD OF THE INVENTION and is not stated in connection with any of the embodiments of Hyppanen applied by the Examiner. Further... page 2, lines 5-10 of Hyppanen is in the BACKGROUND OF THE INVENTION and does not represent the specific embodiments described in the document. The aforementioned descriptions in the introductory sections of the Hyppanen documents are a discussion of the art in general, and do not discuss embodiment of the purported invention. One skilled in the art would understand the introductory comments directed to the alternative locations of the heat transfer chambers as background information only. The discussion of the alternative heat transfer chamber locations does not teach one skilled in the art how such location could be applied to the embodiments described in detail later in the document."

Applicant's arguments have been fully considered but they are not persuasive. In summary, Applicants have argued the following points:

Argument #1: The chamber **216** does not have an open top because the chamber is topped by the inclined reactor chamber outlet **226**.

The Examiner respectfully disagrees and maintains that FIG. 2 of Hyppanen clearly shows the chamber **216** having an open top. The incline as noted by Applicant does not close or seal the chamber **216**, but allows for an open communication between the uppermost portion of the chamber **216** and the reactor chamber **212**, via the unobstructed passageway labeled as reactor chamber outlet **226**.

Argument #2: One of ordinary skill in the art would not have looked to the FIELD OF THE INVENTION or BACKGROUND OF THE INVENTION sections of disclosure of Hyppanen to find motivation for shifting the location of the heat transfer chamber because introductory sections are only a discussion of the art in general, and therefore do not contribute to the detailed embodiments of the invention.

In response, please note that patents are relevant as prior art for all they contain. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983); *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). Also, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, one of ordinary skill in the art at the time the invention was made would have had motivation to shift the location of the chamber to within the processing chamber itself by looking to the teachings of the background information of the Hyppanen reference, despite the fact that such an embodiment is not specifically illustrated.

<u>Comments regarding rejection of claims 5, 7-12, 14, 17-21 and 23-26 under 35 U.S.C. 103(a) as being unpatentable over Dietz (US 5,299,532) in view of Hyppanen.</u>

On page 4, second to last paragraph, Applicants argue,

> "There is no separate open-topped inlet chamber inside the furnace for directing the solid material to the inlet of the process chamber... The chambers **94a** and **94b** communicate with chambers **92a**, **96a**, **92b** and **96b** through openings **112a**, **114a**, **112b** and **114b** (Fig. 4), which are all closed at the top (partition portions **24a''** and **24b''**), rather than open, as recited in claim 24."

On page 4, last paragraph, Applicants further argue,

> "... Dietz does not discuss any possible combination of different embodiment and does not even show an embodiment where solid particles are introduced from the internal solid particle circulation. Thus, there is no motivation to combine the teachings of Hyppanen and Dietz as suggest by the Examiner, and the proposed combination can only be reached through improper use of hindsight."

Applicant's arguments have been fully considered but they are not persuasive. In summary, Applicants have argued the following points:

Argument #1: The inlet chambers **94a** and **94b** do not have open tops because the chambers are closed at their tops with partition portions **24a''** and **24b''**.

The Examiner respectfully disagrees and maintains that the chambers **94a** and **94b** structurally meet the claims. In the rejection, the inlet chambers **94a** and **94b** are being defined as the spaces strictly located between partitions **88a** and **90a**, and between partitions **88b** and **90b**, respectively (see FIG. 2). As can be seen in FIG. 4, these partitions extend upward in a vertical direction, but their upper edges stop before meeting with the upper partition portions **24a''** and **24b''**. Thus, the tops of the chambers **94a** and **94b** are defined at the upper edges of partitions **88a**, **88b**, **90a** and **90b**, and these tops are shown to be open. Being that the inlet chambers **94a** and **94b** are located inside the furnace (see FIG. 1,2), the open tops of the inlet chambers **94a** and **94b** are also located inside the furnace.

Argument #2: The Examiner has used improper hindsight in combining the teachings of Hyppanen and Dietz.

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Jennifer A. Leung
May 31, 2005

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